



**UNITED STATES DEPARTMENT OF COMMERCE
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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
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08/926,246 09/05/97 SULLIVAN

M SLD-2035-1-2

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QM12/0717

EXAMINER

GRAHAM, M

ART UNIT

PAPER NUMBER

3711

DATE MAILED:

07/17/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

08/926,246

Applicant(s)

Sullivan

Examiner

Mark S. Graham

Group Art Unit

3711



☒ Responsive to communication(s) filed on May 8, 2000.

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-8 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-8 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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In response to applicant's first remarks the office regrets the delay in the recitation of the rejections advanced in the 12/13/99 rejection. As has been discussed with applicant, the retirement of the senior examiner in the art, misfiling of papers between various of applicant's applications and the dispersal of applicant's large volume of applications with overlapping subject matter to various examiners previously not working in the art contributed to the delay. Additionally however, applicant's lack of communication between in-house and out-of-house counsel resulting in duplicate applications and duplicate claims and lack of clarity as to which cases applicant considers to be related has contributed to the problem. The delay in the citation of the grounds of rejection based on 35 USC 112 first paragraph though has no bearing on its applicability.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-8 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Each of the following has been identified by the examiner as new matter:

1. In claim 1, the lower limit on the core diameter (29 mm), the upper limit on the core specific gravity (1.4), the limit on the intermediate layer thickness (at least 1 mm), the upper

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limit of the specific gravity of the intermediate layer (1.2), the lower limit of the hardness of the intermediate layer (85 on JIS C), and the upper limit of the thickness range of the cover being claimed (3 mm) was not disclosed in the originally filed specification.

As an example the upper limit on the thickness range of the originally disclosed cover was 1.27 mm.

2. In claim 3, there is no basis provided for the applicant's reasoning that the now claimed hardness range of the cores and covers was inherent in the original specification. Without a basis in the original specification the now claimed ranges must be considered new matter.

3. In claim 5, the lower limit of the diameter of the center core being claimed (29 mm) was not disclosed in the originally filed specification. The lower limit originally disclosed was 35.052 mm.

4. In claim 6, neither the upper or lower limit of the claimed difference in the specific gravity (.5 - .1) was disclosed in the originally filed specification. By applicant's admission the limits of the difference disclosed were (.234 - .164).

5. In claim 7, neither the upper limit (1.0) nor the lower limit (.9) were disclosed in the originally filed specification. While values within that range were disclosed they do not make inherent the upper and lower bounds of the claimed range.

6. In claim 8, neither the upper limit (100) nor the lower limit (85) were disclosed in the originally filed specification. While values within that range were disclosed they do not make inherent the upper and lower bounds of the claimed range.

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In response to applicant's argument "A" on page 2 of the remarks the test for determining compliance with the written description requirement in 35 USC 112 first paragraph is whether the disclosure as originally filed reasonably conveys to the artisan that applicant had possession at that time of the subject matter now claimed. In re Kaslow 217 USPQ 1089. That one skilled in the art might realize from reading the specification that applicant's proposed interpretation may be one possibility among others, is not a sufficient indication to that person that such a possibility satisfies the test for compliance with the description requirement. (Emphasis added) See In re Barker, 194 USPQ 470. Thus, a disclosure cannot be said to "reasonably convey" that the artisan had possession of the claimed subject matter if it is but one possibility among others. Without a showing that the specification disclosed definitively what the applicant now states was intended, to the exclusion of other possibilities, the rejection under 35 USC 112 first paragraph must stand.

Applicant's response to the claim 1 rejection is that although the applicant is claiming a range from 29 mm to infinity, and that the lowest value the disclosure recites is 39.243 mm he has nevertheless disclosed the range which includes 29mm - 39mm. The 39 mm value recited by the applicant is approximately 30% larger than the lower end of the claimed range and nothing in the specification indicates that applicant intended to include anything below 39.243 mm as opposed to other possibilities. Thus, applicant cannot have been said to "reasonably convey" the 29mm-39mm range now being claimed.

The same logic applies to the range of the specific gravity of the core between 1.4 and 1.155. Applicant has simply given no indication that specific gravities in this range were intended

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to be part of his invention among other possibilities. To come back after the fact and copy a patent which was interested in those ranges is the essence of new matter.

Regarding the lower limit of the intermediate thickness, applicant is correct in that this was part of the original disclosure. However, applicant's disclosed ball is not inclusive of thicknesses above 2.54mm whereas that being claimed is.

Concerning the specific gravity of the intermediate layer, the originally filed disclosure is not inclusive of the range between 1.2 and .97 as is now being claimed. Applicant's exhibit A does not address any specific gravities between 1.2 and .99.

With regard to the hardness of the intermediate layer, the originally filed disclosure is not inclusive of the range between 85 and 95.

Concerning the applicant's outer cover thickness, the largest cover thickness originally discloses was 1.27 mm which is not even half of the now claimed 3 mm.

In response to applicant's claim 3 arguments, the applicant freely admits that there would have been possibilities other than that which he now claims. Moreover, how would one know that applicant intended the entire range as opposed to only an upper end of the range?

Regarding the claim 5 arguments, applicant has provided no evidence that a lower limit of 29 mm was disclosed to the exclusion of other possibilities.

Regarding claim 6, applicant has still provided no evidence that values above .234 or below .164 were intended as is now claimed. Thus, values outside of this range represent new matter. Likewise with regard to claims 7 and 8, applicant has still provided no evidence that

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values as high as the upper end of the claimed ranges, or as low as the lower end of the claimed ranges were intended as is now claimed. Thus, values such as these represent new matter. The values now being claimed are only one possibility among an infinite number that applicant might have intended.

Claims 1-8 of this application have been copied by the applicant from U. S. Patent No. 5,553,852. These claims are not patentable to the applicant because they constitute new matter under 35 U.S.C. 112 1st paragraph.

An interference cannot be initiated since a prerequisite for interference under 37 CFR 1.606 is that the claim be patentable to the applicant subject to a judgement in the interference.

Applicant's arguments filed 5/8/00 have been fully considered but they are not persuasive.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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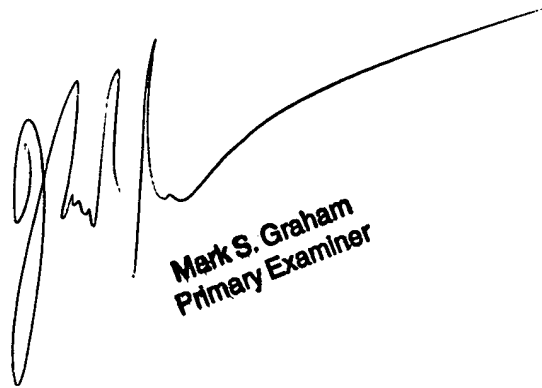
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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication should be directed to Mark S. Graham at telephone number (703) 308-1355.

MSG
July 14, 2000



Mark S. Graham
Primary Examiner